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EXAMINER

LIGHTFOOT, ELENA TSOY

ART UNIT	PAPER NUMBER
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1715

NOTIFICATION DATE	DELIVERY MODE
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09/07/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action

The amendment filed on August 30, 2010 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: the proposed amendment does not place the application in better form for appeal because it does not remove 112, second paragraph issues addressed in the Final Office Action mailed on 5/28/2010. According to nomenclature rules of UPAC, DYNASYLAN® of formula $(\text{EtO})_3\text{Si}-\text{CH}_2-\text{CH}_2-(\text{CF}_2)_5-\text{CF}_3$ (which is Dynasilan 8261 according to the chart submitted by Applicants on 8/30/10) cannot be named tridecafluoro-1,1,2,2-tetrahydrooctyl-1-triethoxysilane even though it has 4 hydrogen atoms in 1,2 positions in the octyl substituent for at least the reason that according to UPAC, the same number “1” cannot be used in a compound name as reference to two different atoms: Si atom in silane and C atom in octyl. The correct chemical name of $(\text{EtO})_3\text{Si}-\text{CH}_2-\text{CH}_2-(\text{CF}_2)_5-\text{CF}_3$ is 3,3,4,4,5,5,6,6,7,7,8,8,8-tridecafluorooctyltriethoxysilane. Thus, claim 1 recites correct and incorrect version of the same compound DYNASYLAN®.

Response to Arguments

Applicant's arguments filed August 30, 2010 have been fully considered but they are not persuasive.

(A) Applicants submit: “The Examiner states that: "Claim 22 recites "tridecafluoro-1,1,2,2-tetrahydrooctyl-1- triethoxysilane", which is confusing ... For examining purposes the phrase was interpreted as "tridecafluoro-1,1,2,2-tetrahydrooctyl-1-triethoxysilane".”

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The Examiner respectfully disagrees with this statement. The Examiner interpreted the phrase as "tridecafluoro-1,1,2,2-tetrahydrooctyl-1-triethoxysilane" NOT as "tridecafluoro-1,1,2,2-tetrahydrooctyl-1-triethoxysilane".

(B) Applicants submit that according to IUPAC, the numbering in a compound has to be done in such way that **the numbers obtained are as small as possible**. As a result, tridecafluoro-1,1,2,2- tetrahydrooctyl-1-triethoxysilane (DYNASYLAN® F 8261) in Claim 22 (now Claim 1) has the constitutional formula: $(\text{EtO})_3\text{Si}-\text{CH}_2-\text{CH}_2-(\text{CF}_2)_5-\text{CF}_3$.

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The Examiner respectfully disagrees with this argument. Note that the chemical name “tridecafluoro-1,1,2,2-tetrahydrooctyl-1-triethoxysilane” is based on “**silane**” wherein Si atom is numbered “1”. Then, the name is incorrect for at least the reason that according to UPAC, if Si is numbered “1”, octyl could not have the same number “1” in the same molecule. Further, according to UPAC, if Si is numbered “1”, triethoxy substituents should be recited as **1,1,1**-triethoxysilane (showing that all three EtO groups are located at the same Si atom). Thus, if Si is numbered “1”, the correct chemical name would be 1-(tridecafluoro...octyl)-1,1,1-triethoxysilane.

(C) Applicants submit that tridecafluoro-1,1,2,2-tetrahydrooctyl-1-triethoxysilane is a correct name for $(\text{EtO})_3\text{Si}-\text{CH}_2-\text{CH}_2-(\text{CF}_2)_5-\text{CF}_3$ because the CAS-No. 51851-37-7, reads „1H,1H,2H,2H-Perfluorooctyltriethoxysilane”.

The Examiner respectfully disagrees with this argument because CAS-No. 51851-37-7 shows the *structure* of the compound NOT its chemical name according to UPAC.

(D) Applicants submit that Dynasilan F 8261 is NOT the same as Dynasilan 8262.

The Examiner respectfully disagrees with this argument because according to the chart submitted by Applicants on August 30, 2010, Dynasilan 8262 is Dynasilan F 8261 in ethanol. Since Dynasilan F 8261 (tridecafluorooctyltriethoxysilane) does not react with ethanol, but dissolves in ethanol, Dynasilan F 8261 is the same as Dynasilan 8262. Thus, Applicants contradict their own chart.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELENA Tsoy LIGHTFOOT whose telephone number is (571)272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy Lightfoot, Ph.D.
Primary Examiner
Art Unit 1715

September 1, 2010

/Elena Tsoy Lightfoot/